

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID FARCOT,
JEAN-FRANCOIS GONTHIER,
and HENRI RANCON

Appeal No. 2007-1463
Application No. 10/083,492
Technology Center 3600

Decided: September 24, 2007

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and JENNIFER D. BAHR,
Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 1-4, 6, 7, 9, 10, 13, 16-18, 23-25, 28-30, 35-38, 40, and 41.¹ 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6 (b) (2002).

¹ Claims 5, 8, 11, 15, 19, 21, 22, 26, 27, and 31-34 have been indicated as containing allowable subject matter, but are objected to for depending upon rejected claims. Final Rejection, mailed Oct. 16, 2003, p. 1.

of the boot (not shown); a disk (20) to retain the base (3) on the gliding board (2) and having at least two parallel elongated holes (e.g., 35) with screws (e.g., 31); and a single plate (shown in footnote 2 consistent with the description in the Specification, p. 7, para. [0036]) parallel to the disk (20) slidable along the lengths of the elongated holes (of the disk) (e.g., 35) and having at least two holes (e.g., 51) extending through the plate. According to Fig. 2³, the plate (50) and the disk screws (e.g., 31) are configured so that the plate retains the screws on the disk (20).

³ Appellants' Fig. 2 is reproduced below.

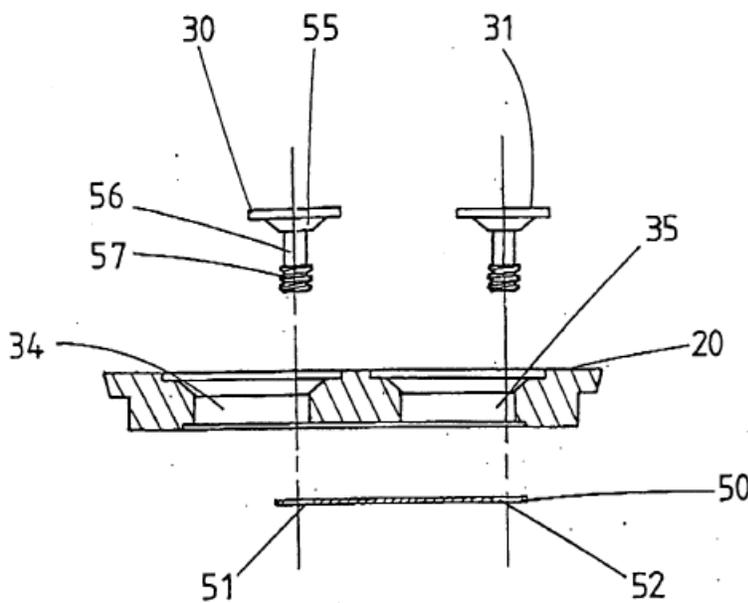


FIG. 2

Fig. 2 is a partial cross-sectional view of the retaining assembly of the present invention.

The claims are rejected as follows:

- Claims 35-38, 40, and 41 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement;
- Claims 6, 38, and 41 are rejected under 35 U.S.C. §112, second and sixth paragraphs, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and,
- Claims 1-4, 6, 7, 9, 10, 13, 16-18, 23-25, 28-30, 35-38, 40, and 41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Keller (US Patent 5,909,893) in view of Vitali (US Patent 5,380,031).

We AFFIRM.

Appellants, in the Appeal Brief⁴, argue the claims in accordance with the following groups:

- claims 35-38, 40, and 41 with respect to the rejection under the first paragraph of 35 U.S.C. § 112 (Br. 6-11);
- claims 6, 38, and 41 with respect to the rejection under 35 U.S.C. §112, second and sixth paragraphs (Br. 11-13); and,
- with respect to the rejection under 35 U.S.C. §103(a)⁵,

⁴ Our decision will make reference to Appellants' Appeal Brief ("Br.," filed Sep. 17, 2004 and the Examiner's Answer ("Answer," mailed Nov. 22, 2005).

⁵ Although the Brief (p. 6) states that "claims 1 and 3 can be considered to stand or fall together, and claims 7, 9, 13, 16, 17, 24, 25, 29, 30 can be considered to stand or fall together", this statement does not cover all the claims rejected and does not comport with the claim groupings as argued later in the Brief.

- claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 (Br. 13-22);
- claims 23 and 28 (Br. 22);
- claim 2 (Br. 22-23); and,
- claims 4 and 10 (Br. 23-24).

Written description requirement of the first paragraph of 35 U.S.C. § 112

Appellants argue claims 35-38, 40, and 41 as a group. However, for reasons discussed below, we will treat claims 35-37, and claims 38, 40, and 41 as separate groups. Pursuant to the rules, the Board selects representative claim 35 to decide the appeal with respect to the rejection of the former group and claim 38 for the latter group. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

Claims 35 reads as follows:

35. A retaining assembly according to claim 1⁶, wherein said single plate has a predetermined size and shape, wherein said single plate is the only plate of the retaining assembly having said predetermined size and shape, the retaining assembly thereby not including a second plate having said predetermined size and shape.

38. An assembly adapted to retain a boot on a sports apparatus, said assembly comprising:

a base adapted to be supported on the sports apparatus and adapted to support a sole of the boot, said base comprising:

a through opening; and

a disk supportable above said through opening, at least two elongated holes extending through a thickness of said disk, each of said two elongated holes being elongated in the same direction;

⁶ Claim 1 is reproduced infra.

a plate having a predeterminate size and shape, said plate being the one and only plate of said assembly having said predeterminate size and shape;

said plate being slidably positionable relative to said base in the direction of said elongated holes, said plate having at least two holes extending through a thickness of said plate;

a plurality of screws, each of said screws having a single predeterminate size and shape to extend through a respective one of said elongated holes of said base, through a respective one of said holes of said plate, and into an upper surface of the sports apparatus to secure said base onto the sports apparatus;

said plurality of screws comprising means for retaining said plate connected to said base when said plurality of screws are not screwed into the sports apparatus.

A. Issue

The issue is whether Appellants have shown error in the Examiner's rejection on the grounds that the Specification does *not* reasonably convey to those skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed retaining assembly wherein *said single plate is the only plate of the retaining assembly having said predetermined size and shape, the retaining assembly thereby not including a second plate having said predetermined size and shape.*

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Fig. 1 of the Specification shows a single plate.
2. The Specification does not disclose the existence of a second plate or the absence of a second plate in a retaining assembly.

C. Principles of Law

1. “What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736, 62 USPQ2d 1705, 1712 (2002).
2. All that is necessary to satisfy the description requirement is to show that one is “in possession” of the invention. Lockwood accurately states the test. See *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); and *Vas- Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

One shows that one is “in possession” of *the invention* by describing *the invention*, with all its claimed limitations, *Id.* (“ [T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed.*”) (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used *in haec verba*, see *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (“ [T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims.. . .”), the specification must contain an equivalent description of the claimed subject matter.

Lockwood v. American Airlines, Inc., 107 F.3d at 1572, 41 USPQ2d at 1966 (emphasis original).

3. Compliance with the written description requirement is a question of fact. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).

D. Analysis

The issue of whether Appellants have shown error in the Examiner's rejection on the grounds that the Specification does *not* reasonably convey to those skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed retaining assembly wherein *said single plate is the only plate of the retaining assembly having said predetermined size and shape, the retaining assembly thereby not including a second plate having said predetermined size and shape* applies only to claims 35-37.

The issue with respect to claims 38, 40, and 41 is whether the Specification reasonably conveys to those skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed retaining assembly wherein the plate has a predeterminate size and said plate being the one and only plate of said assembly having said predeterminate size and shape. We note the use of the open-ended term "comprising" in claim 35, both in the preamble and immediately preceding the recitation of a single plate, and the absence of an express limitation excluding the presence of another such plate. A retaining assembly wherein the plate has a predeterminate size and said plate being the one

and only plate of said assembly having said predetermined size and shape is clearly shown in Fig. 1 of the Specification (see footnote 2). Accordingly we will not sustain the rejection as to these claims.

However, we will sustain the rejection as to claims 35-37.

There is no dispute that the Specification nowhere discloses a retaining assembly wherein *said single plate is the only plate of the retaining assembly having said predetermined size and shape, the retaining assembly thereby not including a second plate having said predetermined size and shape*. There is not a single word anywhere in the original Specification which would suggest the pre-existence of a second plate or its subsequent absence in the final retaining assembly.

If we understand the argument correctly, Appellants submit that, notwithstanding that it is conceded that “the disclosure does not distinguish the single plate from the second plate based on size and shape’ is correct [] in the limited sense that the literal text of the specification does not distinguish the single plate from a second plate based upon size and shape” (Br. 10), Appellants’ claimed invention necessarily provides “for there being no second plate” (Br. 11). We are not persuaded by this argument. We can find nothing in the claim or the specification that would convey to one of ordinary skill in the art that Appellants had possession of an assembly eliminating the presence of a second plate.

Appellants cite various decisions in support of their view that they may add the subject matter at issue without having to have literal support for that subject matter in the original disclosure. The question in *In re Wright*, 866 F.2d 422, 9

USPQ2d 1649 (Fed. Cir 1989), was whether the process claimed with the words “not permanently fixed” was described in the specification. While those words were not literally recited in the Specification, the process described therein clearly accomplished that result, and thus the court found the claimed process to be described. The situation before us is different. There is nothing in the Specification that would lead one to the conclusion that a second plate existed which Appellants have necessarily omitted from the final retaining assembly. The other decisions Appellants cite (see Br. 8-11) repeat the axiom that the subject matter of a claim need not be described literally in order for the disclosure to satisfy the description requirement. They do not support the general proposition Appellants appear to be advocating that a Specification’s silence as to an element is a license to later amend the claim to describe the invention in terms of the element’s absence.

E. Conclusion of Law

On the record before us, Appellants have failed to show that the Examiner erred in rejecting claims 35-37 over the prior art but have shown that the Examiner erred in rejecting claims 38, 40, and 41.

Second and sixth paragraphs of 35 U.S.C. §112

Because Appellants argue claims 6, 38, and 41 as a group, pursuant to the rules, the Board selects representative claim 6 to decide the appeal with respect to this rejection, and claims 38 and 41 will stand or fall with claim 6. 37 C.F.R.

§ 41.37(c)(1)(vii) (2006). Claim 6 reads as follows:

6. An assembly for retaining a boot on a sports apparatus, said assembly comprising:

a base provided to support a sole of the boot, the base being adapted to be affixed to the sports apparatus;

a disk provided to retain the base on the sports apparatus, the disk having at least two elongated holes extending through a thickness of the disk;

at least two screws, said screws provided to extend through respective ones of the elongated holes of the disk;

a plate provided to be positioned parallel to the disk and slidable along a surface of the disk, at least two holes extending through a thickness of the plate;

means for retaining the screws on the plate and for connecting the plate to the disk when the base is not affixed to the sports apparatus, all of the at least two screws provided to extend through respective ones of the holes of the plate

A. Issue

The issue is whether claims 6, 38, and 41 run afoul of the second paragraph of 35 U.S.C. § 112.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. The Examiner argues that

Claim 6 defines means for retaining the screws on the plate and for connecting the plate to the disk when the base is not affixed to the sports apparatus. Claims 38 and 41 define the screws as having means for retaining the plate connected to the base when the screws are not screwed into the sports apparatus. However, the structure comprising the means is not clear

under 35 USC 112, paragraph six, as invoked by Applicants on page 12 of the amendment filed April 17, 2003.

Paragraphs 0039-0044 of the specification disclose a means for retaining the screws on the plate including the diameter of the threaded portion of the screw being substantially equal to the diameter of the corresponding hole in the plate. However, *this means would only connect the plate to the disk when the base is not affixed to the sports apparatus if the plate is disposed beneath the base or disk. If the plate were disposed above the base or disk, this means would only retain the screws on the plate and would not connect the plate to the disk.* Thus, the claims are unclear as to whether the means includes the screw diameter at the threaded portion relative to the diameter of the hole in the plate alone or the screw diameter at the threaded portion relative to the diameter of the hole in the plate in combination with the location of the plate being below the base or disk.

In section B. 3. of the remarks to the amendment filed August 18, 2003, Applicants indicate that the limitations in which the plate is disposed in the lower surface of the base or disk are only present in dependent claims. Since the means plus function limitation in question appears in independent claims 6 and 38, for the purposes of examination the means have been interpreted as being the screw diameter at the threaded portion relative to the diameter of the hole in the plate alone without locating the plate below the base or disk. This means would connect the plate to the disk when the base is not affixed to the sports apparatus to the same extent as the claimed.

Answer 4-5. Emphasis added.

2. The Examiner concedes that the claim 6 defines means for retaining the screws on the plate and for connecting the plate to the disk when the base is not affixed to the sports apparatus.

3. However, the Examiner queries whether the breadth of the means language is such that the claim encompasses an inoperative embodiment, i.e., whereby the screws would not connect the plate to the disk when the base is not affixed to the sports apparatus, or is limited to an embodiment wherein the plate is disposed

below the disc or base.

C. Principles of Law

1. The test for compliance is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).
2. Just because a term is broad, does not mean it is indefinite. *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (1970).

D. Analysis

The claim is specifically drawn to a means for retaining the screws on the plate and for connecting the plate to the disk when the base is not affixed to the sports apparatus. In other words, the claim *requires* that the screws on the plate do connect the plate to the disk when the base is not affixed to the sports apparatus. The metes and bounds of the claim is such that it excludes all means which cannot function as the claim provides. That is, the claim excludes means whereby the screws on the plate do *not* connect the plate to the disk when the base is not affixed to the sports apparatus. Any argument that the claim encompasses an embodiment whereby the screws would *not* connect the plate to the disk when the base is not affixed to the sports apparatus, would be reading the claim in a manner inconsistent with the language of the claim. Having said that, however, we see nothing in Appellants' Specification that specifically limits the means for retaining

to a structure wherein the plate is disposed below the disc or base.

E. Conclusion of Law

On the record before us, the Examiner has not established a prima facie case that claims 6, 38, and 41 fail to comply with the second and sixth paragraphs of 35 U.S.C. §112.

35 U.S.C. §103(a)

Claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41

Because Appellants argue claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 as a group, pursuant to the rules, the Board selects representative claim 1 to decide the appeal with respect to this rejection, and claims 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 will stand or fall with claim 35. 37 C.F.R. § 41.37(c)(1)(vii) (2006). Claim 1 reads as follows:

1. An assembly for retaining a boot on a sports apparatus, said assembly comprising:

a base provided to receive a sole of the boot, a disk provided to retain the base on the sports apparatus, the disk having at least two elongated holes, parallel to one another, the elongated holes extending through a thickness of the disk, and at least two screws each extending through respective ones of the elongated holes, the assembly further comprising a single plate parallel to the disk, the plate being slidable along lengths of the elongated holes, at least two holes extending through a thickness of the plate, each of said at least two screws extending through a respective hole of the plate, and means for retaining the screws on the plate.

A. Issue

The issue is whether Appellants have shown that the Examiner erred in holding the combination of Keller and Vitali would have rendered the subject matter of claim 1 obvious to one of ordinary skill in the art at the time of the invention.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Keller shows a retaining assembly comprising two plates (elements 12 in Fig 3⁷).

⁷ Keller's Fig. 3 is reproduced below:

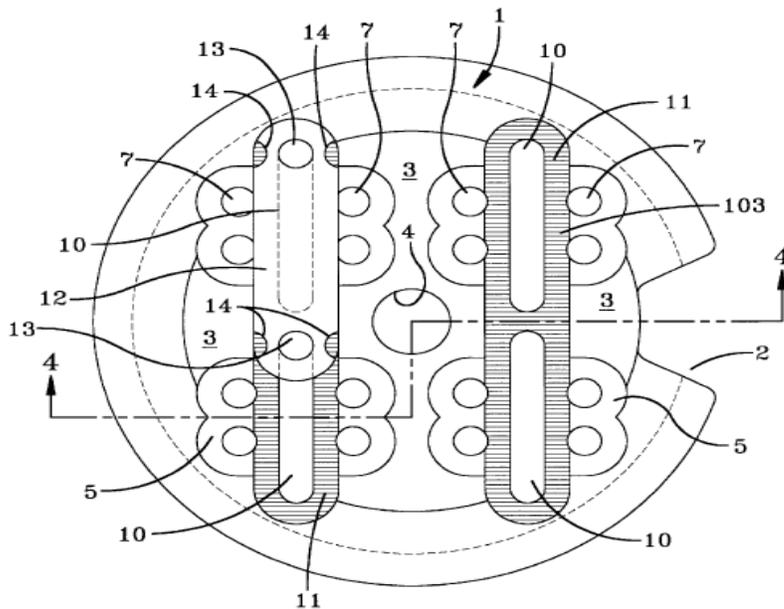


FIG-3

Fig. 3 shows a retaining assembly comprising two plates (elements 12).

2. The Examiner found that Keller discloses

an assembly for retaining a boot on a sports apparatus. See figure 3; column 2, lines 44-50; and column 4, lines 6-29. The assembly has a disk 1 that retains a base 9 and is supported above a through opening of the base, wherein the disk includes four elongated holes 10 that extend through a thickness of the disk, are parallel to one another, are aligned in pairs, are elongated in the same direction, and are across from one another. Also, two generally rectangular plates 12 that are parallel to the disk and are housed in a cavity 11 of the disk, wherein the cavity has a generally parallelepipedic contour. Each plate includes two holes 13 extending through a thickness of the plate and each plate slides along the length of the elongated holes. At least two screws 8 extend through the elongated holes of the disk, the holes of each plate, and into an upper surface of the sports apparatus.

Answer 6.

3. The Examiner found that Keller did not disclose

a retaining means, wherein the means is a plate hole with a diameter substantially equal to the diameter of the threaded portion of the screw, and the screw head and threaded portion interact with the plate hole to retain the screw on the plate as discussed in paragraphs 0039 - 0043. Keller et al does not disclose that the plate is made of plastic or metal. Keller et al. does not disclose the precise thickness of the plate, although it appears to be between 0.1 mm and 1.0 mm based upon the proportions depicted in Figure 3. In addition, the plate is not square with four holes spread to the four corners or three holes arranged at vertices of a triangle, and the size and shape of one plate is not different from the size and shape of the other plate.

Answer 6-7.

4. The Examiner found that Vitali discloses

the old and well known retaining means for retaining screws on a plate, and teaches plate materials and thickness. See Figures 1-6 and column 3, lines 4-16, 23-29, 39-52, and 63-67. The retaining means includes a plate hole 7

with a diameter 9 substantially equal to the diameter of the threaded portion of a screw 1. The screw is sized, relative to the plate hole, to be forcibly screwed through the plate hole, thereby allowing the screw head and threaded portion to interact with the plate hole to retain the screw on the plate when assembled. Also, the plate may be made of either plastic or metal and has a thickness of between 0.1 mm and 1.0 mm.

Answer 7.

5. The Appeal Brief argues that the claimed retaining assembly contains one and only one plate. Br. 13-19.

6. Claim 1 describes the plate as follows: “the assembly further comprising a single plate”.

C. Principles of Law

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in

Graham further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

D. Analysis

The principal issue is whether the claimed assembly is limited so as to include no more than one plate. We agree with the Examiner that it does not. The claim clearly states that the assembly comprises a single plate. Given the open-ended language of the claim, the claim encompasses an assembly with more than one single plate. We are not persuaded by any of the arguments Appellants make in advocating an interpretation of the phrase “single plate” that would confine the claimed assembly to one that included no more than one single plate. Claims are given the broadest reasonable construction consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). “The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’ *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 [70 USPQ2d 1827, 1830] (Fed. Cir. 2004).” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005). Appellants do not point to anywhere in the Specification that would support the view that the broadest reasonable construction of the claim in light of the Specification as it would be interpreted by one of ordinary skill in the art is that the claimed assembly

contains no more than one single plate. Here Appellants provide no evidence that one of ordinary skill in the art would interpret “single plate” to mean that it is the sole plate in the assembly.

Appellants also argue that the references do not show “means for retaining the screws on the plate” (claim 1) and “means for retaining the screws on the plate and for connecting the plate to the disk when the base is not affixed to the sports apparatus” (claims 6, 38, and 41). However, a close inspection of Keller (see Fig. 3; see also footnote 7 of this Decision) shows that the holes (element 13) in the plate receive screws (col. 4, l. 56) which retain and connect the plate (element 12) to the disk (element 1) when the base (element 9) is not affixed to the sports apparatus.

E. Conclusion of Law

On the record before us, Appellants have failed to show that the Examiner erred in rejecting the claims over the prior art.

Claims 23 and 28

Because Appellants argue claims 23 and 28 as a group, pursuant to the rules, the Board selects representative claim 23 to decide the appeal with respect to this rejection, and claim 28 will stand or fall with claim 23. 37 C.F.R.

§ 41.37(c)(1)(vii) (2006). Claim 23 reads as follows:

Claim 23. A retaining assembly according to claim 7, wherein all of the at least two screws are sized, relative to respective ones of the holes of the plate, to be forcibly screwed through said respective ones of the holes of the plate.

A. Issue

The issue is whether Appellants have shown that the Examiner erred in holding the combination of Keller and Vitali would have rendered the subject matter of claim 23 obvious to one of ordinary skill in the art at the time of the invention.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. We incorporate herein the facts under the Findings of Fact section for the rejection of claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 above and add the following facts.
2. Appellants argued that Keller does not show screws forcibly screwed in the plate as required by claims 23 and 28. Br. 22.
3. However, as the examiner pointed out (Answer 18), Vitali at col. 3, ll. 50-52 states "...the screw 1 can be inserted by force into the hole 7..." and shows forcibly screwing.
4. Appellants did not address Vitali.

C. Principles of Law

We incorporate herein the principles of law under the Principles of Law section for the rejection of claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 above.

D. Analysis

Appellants argue that Keller does not show forcibly screwing the screws into the plate. However, the Examiner also applied Vitali and showed that forcibly screwing is taught in that reference. The Examiner sought to establish a prima facie case of obviousness based on what the *combined* teachings of the references would suggest to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Whether or not an individual reference teaches a specific element of the claimed assembly is not dispositive of the question of obviousness. Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. *In re Merck*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

E. Conclusion of Law

On the record before us, Appellants have failed to show that the Examiner erred in rejecting the claims over the prior art.

Claim 2

Claim 2 reads as follows:

Claim 2. A retaining assembly according to claim 1, wherein the plate is located on a lower portion of the disk.

A. Issue

The issue is whether Appellants have shown that the Examiner erred in holding the combination of Keller and Vitali would have rendered the subject matter of claim 2 obvious to one of ordinary skill in the art at the time of the invention.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. We incorporate herein the facts under the Findings of Fact section for the rejection of claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 above and add the following facts.
2. Appellants argue that

Claim 2 specifies that the plate "is located on the lower portion of the disk." The lower surface of the cavity 11 of KELLER's disk 1 does not appear to be located even in the lower half of the disk. Appellants submit that it would not be properly characterized as being location "on the lower portion of the disk."

That is, the lower surface of cavity 11 of KELLER is not a lower portion of a disk, as specified in Appellants' claim 2.

In this regard a "surface" is not a portion; a surface is only a two-dimensional aspect of something. Second, surface 11 is not in a lower portion of "fastening plate 1" of KELLER. Thus, in what sense, can the surface 11 of KELLER be regarded as a "lower portion" of the disk?

Br. 23.

C. Principles of Law

We incorporate herein the principles of law under the Principles of Law section for the rejection of claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 above.

D. Analysis

There is no dispute that the plate (element 12, Fig. 3) of Keller sits in a cavity (element 11) in a disk (element 1). The only question is whether in doing so Keller shows locating the plate “on the lower portion of the disk.” In that regard, we agree with the Examiner’s analysis that this question turns on the interpretation to be given the claim term “portion.” Answer 18. The Examiner correctly gave the term the plain meaning of the term, citing a dictionary definition which defined the term as “a part of a whole.” The Specification, for its part, does not define the term inconsistent with its plain meaning. We agree with the Examiner that the broadest reasonable interpretation of the claim in light of the Specification as it would be interpreted by one of ordinary skill in the art is that it covers the plate being disposed below the surface of the disk. Since Keller shows that arrangement, Keller shows locating the plate “on the lower portion of the disk” as claimed.

E. Conclusion of Law

On the record before us, Appellants have failed to show that the Examiner erred in rejecting the claims over the prior art.

Claims 4 and 10

Because Appellants argue claims 4 and 10 as a group, pursuant to the rules, the Board selects representative claim 4 to decide the appeal with respect to this rejection, and claim 10 will stand or fall with claim 4. 37 C.F.R. § 41.37(c)(1)(vii) (2006). Claim 4 reads as follows:

Claim 4. A retaining assembly according to claim 3, wherein the plate has a generally square shape, and wherein the cavity has a generally parallelepipedic shape.

A. Issue

The issue is whether Appellants have shown that the Examiner erred in holding that the combination of Keller and Vitali would have rendered the subject matter of claim 4 obvious to one of ordinary skill in the art at the time of the invention.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. We incorporate herein the facts under the Findings of Fact section for the rejection of claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 above and add the following facts.

2. Appellants argue in its entirety:

e. Generally Square Plate within Generally Parallelepipedic Cavity
Claim 4, which depends serially from claims 1 and 3; claim 10, which depends serially from claims 7 and 9; and claim 18, which depends serially

from claims 13 and 17, specify that the plate of the retaining assembly of the invention has a generally square shape and that the cavity of the disk in which the plate is housed has a generally parallelepipedic shape.

This combination is not taught or suggested by the combination of KELLER and VITALI and, accordingly, the rejection of claims 4 and 10 should be reversed.

Br. 23.

C. Principles of Law

We incorporate herein the principles of law under the Principles of Law section for the rejection of claims 1, 3, 5, 6, 7, 9, 13, 16-18, 24, 25, 29, 30, 35-38, 40, and 41 above.

D. Analysis

Appellants' argument (FF 2) is no more than a general allegation that the art does not teach a claim limitation. This sort of argument does no more than merely point out the recitation of a claim limitation. In that regard, a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

E. Conclusion of Law

On the record before us, Appellants have failed to show that the Examiner erred in rejecting the claims over the prior art.

DECISION

The rejection of claims 35-37 38, 40, and 41 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement is affirmed but the rejection of claims 38, 40, and 41 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement is reversed;

the rejection Claims 6, 38, and 41 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is reversed; and,

the rejection of claims 1-4, 6, 7, 9, 10, 13, 16-18, 23-25, 28-30, 35-38, 40, and 41 under 35 U.S.C. §103(a) as being unpatentable over Keller in view of Vitali is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

vsh

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